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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number Q78036 |
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Application Number | Filed |
| | 10/693,928 | October 28, 2003 |
| | First Named Inventor | |
| | Isao OKADA | |
| | Art Unit | Examiner |
| | 2633 | Latanya BIBBINS |
| <p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p> | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number 25,426</p> <p style="text-align: right;">_____ <i>/Alan J. Kasper/</i> Signature</p> <p style="text-align: right;">_____ Alan J. Kasper Typed or printed name</p> <p style="text-align: right;">_____ (202) 293-7060 Telephone number</p> <p style="text-align: right;">_____ August 6, 2007 Date</p> | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q78036

Isao OKADA, et al.

Appln. No.: 10/693,928

Group Art Unit: 2633

Confirmation No.: 4142

Examiner: Latanya BIBBINS

Filed: October 28, 2003

For: RECORDING PULSE GENERATOR

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated February 5, 2007, Applicants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicants turn now to the rejections at issue:

Claims 1-16, all of the claims pending in the application, are rejected under 35 U.S.C. § 103(a) on the following bases:

- (1) **Claims 1 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publ. No. 2002/0051415 to Iijima ("Iijima") in view of Applicants Admitted Prior Art ("AAPA");**
- (2) **Claims 2, 3, and 6-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of AAPA and U.S. Patent No. 6,493,305 to Hayashi et al. ("Hayashi");**
- (3) **Claims 5 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of AAPA and U.S. Patent No. 5,818,805 to Kobayashi et al. ("Kobayashi")**
- (4) **Claims 10, 11, and 13-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of AAPA, Hayashi, and Kobayashi.**

Applicants respectfully submit that the claimed invention is patentable because (1) the background disclosure in the specification does not constitute an admission of statutory “prior art” and (2) even if prior art, the combination of references would not have been rendered the claimed invention obvious.

I. Applicants’ Specification Does Not Disclose Statutory Prior Art”

The Examiner asserts that the Background of the Invention section of the Specification at pages 4-8 and FIG. 13 have been admitted as “prior art” or, in the alternative, that the admission of “conventional Art” can be a basis for rejection.

No Admission of Prior Art

Neither the title, text or content of the specification and drawings admit that the disclosure at pages 4-8 and Fig. 13 are statutory “prior art.” Just the contrary, the text clearly states that the disclosed structure is NOT prior art.

The relevant portions of the Specification include: the “Background of the Invention” section, which is labeled “Description of the Related Art.” The term “prior art” is not used at all. The text only refers to the disclosed structure as “conventional” (page 4, line 12). Moreover, the text expressly states that FIG. 13 “is not known as a prior art document” (page 4, lines 13 and 14). Finally, the text expressly states that “with regard to the present invention, any disclosed document of prior art was not found” (page 8, lines 5 and 6).

In short, Applicant has given no indication at any time from filing to this submission that the disclosure in the Background section is prior art. Indeed, Applicant has intentionally avoided use of the term “prior art” and has consistently maintained that the “related art” is not prior art.

Case Law is Contrary to Examiner’s Position

There are no court or administrative decisions that support the Examiner’s position. The only case law cited by the Examiner, *In re Nomiya*, 509 F.2d 566 (CCPA 1975), supports Applicants’ position.

Specifically, the Examiner cites *In re Nomiya* for the proposition that the Background of the Invention section has relevant portions that constitute an admission of prior art. (Advisory Action Before the Filing of an Appeal Brief at page 3). The Examiner’s reliance on *Nomiya* is completely misplaced.

In *Nomiya*, the patentees filed a patent application containing two drawing figures expressly labeled as “prior art” and accompanied by statements explaining the figures. The patentees were citizens and residents of Japan and had pointed out that what may have been known in Japan “would not be prior art by virtue of any portion of 35 USC 102.” *Nomiya*, at 570. However, the CCPA held that “[b]y filing

an application containing Figs. 1 and 2, labeled prior art, *ipsisismis verbis* [in those very words], and statements explanatory thereof, appellants have conceded what is to be considered as prior art in determining obviousness of their improvement.” *Nomiya*, at 571 (emphasis added). Only because the Applicants used the very words “prior art” did the Court accept the Examiner’s position. In this special case, a showing of statutory basis under § 102 that the disclosure qualifies as prior art was not necessary.

In dramatic contrast, Applicants have not admitted that anything is “prior art”, using those very words, and the narrow, but important, holding of *Nomiya* does not apply. Furthermore, the Examiner’s argument that labeling the text “Description of the Related Art” verses “Description of the Prior Art” is an exercise in form over substance does not compel that *Nomiya* should apply. Applicants intentionally used the phrase “Related Art” because the material disclosed in the background section is not known to be prior art. The use of the words “related” and “prior” is more than just form over substance because the words have drastically different meanings.¹ This difference has been used by Applicants and accepted by the USPTO for decades as being well understood.

Nomiya is very specific about requiring that the patentee state that the disclosure is “prior art”, *ipsisismis verbis*, because only then has the patentee acknowledged that something was prior art. *Nomiya* is based upon an acknowledgment by the Court that Applicants can describe background art in a manner that helps understand the inventive advance, without facing a rejection on the basis of that background, unless there is an express statement admitting that the disclosure is prior art. To substitute the words “related” for “prior” as the Examiner proposes is contrary to *Nomiya*’s premise. Neither *Nomiya* nor other Court decisions support the Examiner’s application of Applicants’ disclosure as prior art.

In *Hellsund*, the patentee had admitted that certain disclosures in the Opel patent had been invented prior to his invention. *In re Hellsund*, 177 U.S.P.Q. 170 (CCPA 1973). The majority relied on the patentee’s response expressly saying that the prior invention was prior art. Clearly, there is no such admission in this case. More notably, however, in *Hellsund*, the concurring opinion by Judge Rich emphasized the need for the Examiner to specifically demonstrate a statutory basis for considering the Opel disclosure as prior art. Judge Rich stated that “[a]dmitted prior *invention* is not necessarily ‘prior

¹ “Related art” means art that is close to ones claimed invention while “prior art” has special meaning under § 103 which means art that can be used in determining obviousness of an invention. “Related art” is not necessarily “prior art”, e.g., if the art was published after a critical date.

art’ under § 103”, and that important safeguards carefully written into § 102 would be discarded if the statutory basis was not analyzed, such as § 102(g)’s requirement that there be no abandonment, suppression, or concealment. *Hellsund*, at 174. Similarly, a statutory bar under either § 102 (b), (c), or (d) has been required in order for a patentee’s own invention to constitute prior art for him regardless of whether the patentee admits knowledge of his own work. *Reading & Bates Constr. Co. v. Baker Energy Res. Corp.*, 223 U.S.P.Q. 1168, 1171-72 (Fed. Cir. 1984).

No Identified Statutory Support

The Examiner does not state under what statutory basis the Applicants’ disclosure qualifies as prior art, and the Examiner only summarily states that referring to the structure as “conventional” constitutes prior art. Without such statutory support, the Examiner’s position cannot be maintained. Furthermore, on the basis of Judge Rich’s opinion in *Hellsund*, admitted “prior invention” is not necessarily “prior art,” and admitting that something is “conventional” does not necessarily admit it is prior art.² Therefore, since the Examiner has not and cannot show any statutory basis under which the disclosure qualifies as prior art, the use of the word “conventional” cannot be deemed as admission that the Background structure is prior art.

II. Claim Rejections - 35 U.S.C. § 103

A. Claim 1

Applicants respectfully submit that the claimed invention as set forth in claim 1 would not have been rendered obvious in view of the combinations of the cited prior art. For example, with the exclusion of the AAPA from this rejection, Applicants respectfully rely upon their arguments made in the amendment dated November 20, 2006 for patentability. Clearly the Examiner found those arguments convincing, as he did not maintain the rejection but felt he had to add the Background of the Invention teachings for support. Further, the Examiner expressly admits that Iijima fails to teach a level shift stage that generates the plural fine clocks to be selected by the selector.

² Applicants note, similar to what the Appellants point out in *Nomiya*, that the inventors are from Japan, and that what is known or conventional in Japan would not be prior art by virtue of any portion of 35 U.S.C. § 102. Applicants do not state where or when the disclosure is conventional, but Applicants do state that, at least with respect to the U.S., FIG. 13 “is not known as a prior art document”. (emphasis added)

Substantively, Applicants also submit that the illustrated level shift stage 22 in Fig. 13 of the present application does not teach or suggest that the stage may be used in the claimed circuit to generate fine clocks to be selected by the selector. Withdrawal of the rejection is respectfully requested.

B. Claim 2

The invention defined by claim 2 would not have been rendered obvious in view of the combinations of the cited prior art. Again, with the exclusion of the AAPA from this rejection, Applicants rely upon their arguments made in the amendment dated November 20, 2006 for patentability.

Furthermore, neither Iijima nor Hayashi discloses or suggests a recording pulse generator wherein a PLL oscillator compares (1) the phase of a signal generated by the oscillator with (2) the phase of the clock inputted to the first stage of the first delay line, as claimed in claim 2.

In Hayashi, the PLL circuit 3 compares the phase of the oscillation output signal with the phase of reference signal RFCK, which is not inputted into the first stage of the first delay line. Hayashi at FIG. 9 and col. 9 lines 39-57. Only the input signal SIN is inputted into the first stage of the first delay line. The input signal SIN is not compared by the PLL oscillator 3. In contrast, according to the invention, the EFMCLK is inputted into both the first stage of the first delay line and the PLL oscillator. (FIG. 1)

Because the input signal SIN is not compared by the PLL circuit 3, and the reference signal RFCK is not inputted to the first stage of the first delay line, the combination of Iijima and Hayashi does not disclose or suggest all the recitations of claim 2. Therefore, claim 2 is not rendered unpatentable by the cited references and respectfully request withdrawal of the rejection.

C. Claims 3-16

The claimed invention as set forth in claim 3-16 would not have been rendered obvious in view of the combinations of the cited prior art. Again, with the exclusion of the AAPA from this rejection, Applicants respectfully rely upon their arguments made in the amendment dated November 20, 2006 for patentability and respectfully request withdrawal of the rejections.

Respectfully submitted,
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WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: August 6, 2007